

REMARKS

Claims 16-40 are pending in this application. Base claims 16, 22, 24, 25 and 26 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections while claims 35-40 have been newly added in accordance with current Office policy, to depend upon base claims 16, 22, 24, 25 and 26 to further define Applicants' disclosed invention relative to the cited prior art and to assist the Examiner to expedite compact prosecution of the instant application.

The abstract of the disclosure has been objected to because its length exceeds 150 words. Actually, the provision under 37 C.F.R. §1.72(b) only requires the Abstract to be written for purposes of enabling PTO personnel and the public to determine quickly from a cursory inspection the nature and gist of the invention. While the Manual of Patent Examination Procedure (M.P.E.P.) encourages the Applicants to limit the Abstract to 25 lines of text, there is no legal basis for such limitation. As expressly stated in its Foreword, the Manual of Patent Examination Procedure (M.P.E.P.) "does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations." Nevertheless, for purposes of expedition, the Abstract has been amended to avoid the use of legal phraseology and to overcome this objection.

Lastly, claims 16-30 have been rejected under 35 U.S.C. §102(e) as being anticipated by Hirota, U.S. Patent No. 5,568,390 for reasons stated on pages 3-4 of the Office Action (Paper No. 6). Specifically, the Examiner asserts that,

"Hirota discloses an information terminal for providing plan information of a path from a current place of said information terminal to a destination point in response to a destination information designated from a user and the current place of said information

terminal, comprising: receiving means which receives traffic jam information via a receiver from a radio network; determining means which determines to change plan information based on said traffic jam information having a shorter time every time duration; alternative plan generating means which provides an alternative plan of a path from said current place of said information terminal to said destination point when said determining means determines to change said plan information; and outputting means which outputs said alternative plan to [is, sic] a user instead of said plan information (abstract, fig. 1, column 2, lines 63 thru column 3, line 10, column 5, lines 35-66, column 9, line 7 thru column 10, line 61, and column 11, line 6 thru column 12, line 55).

However, the cited Abstract, FIG. 1, column 2, lines 63 thru column 3, line 10, column 5, lines 35-66, column 9, line 7 thru column 10, line 61, and column 11, line 6 thru column 12, line 55 of Hirota '390 disclose a navigation system, as shown in FIG. 1, to be mounted on a vehicle for carrying out a route search on the basis of map information and displaying the searched route. In one specific embodiment shown in FIG. 9, and described on column 10, lines 24-49, Hirota '390 provides guidance to a particular destination or a selected facility (for example, department store) according to new traffic jam information and the like. If new traffic jam information is obtained, then the selected facility may no longer be desirable. Rather, another selected facility may becomes more favorable, in which case, guidance will be issue for a new destination. In other words, Hirota '390 teaches to change the destination and issue new guidance in response to new jam traffic information.

Hirota '390 does not disclose or suggest Applicants' efforts to change, based on new traffic jam information, plan information of a path from a current location of an information terminal to a destination point designated by a user, to provide an alternative plan of a path from the current location of said information terminal to said destination point when changing said plan information is determined, and to produce

the alternative plan to the user instead of the plan information, as generally defined in each of Applicants' base claims 16, 22, 24, 25 and 26.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Hirota '390 fails to disclose and suggest key features of Applicants' base claims 16, 22, 24, 25 and 26. Therefore, Applicants respectfully request that the rejection of Applicants' base claims 16, 22, 24, 25 and 26 and their respective dependent claims be withdrawn.

Nevertheless, in the interest of expedition, base claims 16, 22, 24, 25 and 26 have been amended to further incorporate the use of "filter means" or "filter" arranged to filter and select necessary information from traffic jam information, so that plan information can be changed based on the information selected from the traffic jam information. As amended, Applicants' base claims 16, 22, 24, 25 and 26 are clearly deemed distinguishable over Hirota '390. Therefore, Applicants respectfully request that the rejection of Applicants' claims 16-30 be withdrawn.

Claims 36-40 have been newly added to depend upon base claims 16, 22, 24, 25 and 26. These claims are believed to be allowable at least for the same reasons discussed against all the outstanding rejections of the instant application. For example, claim 36 further comprises,

- "means for storing therein first plan information of a path to a first destination;
- means for storing therein second plan information of a path to a second destination; and
- means for storing therein chain information regarding a chain between said first and second plan information;
- wherein said alternative plan generating means refers to said chain information to show, when said alternative plan generating means is requested to show an alternative plan of said first plan information, both of said alternative plan of said first plan information and an alternative plan of said second plan information."

These components are described on page 30, lines 17-20; page 39, line 27 extending to page 40, line 11, page 53, line 25 extending to page 54, line 3, and page 54, line 21 extending to page 55, line 9 of Applicants' specification, and are not

disclosed or suggested by any prior art of record, including Hirota et al., U.S. Patent No. 5,568,390. A fee of \$90.00 incurred by the addition of five (5) claims in excess of twenty.


In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC area office at (703) 312-6600.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, No. 01-2135 (Application No. 500.36066CX1), and please credit any excess fees to said deposit account.

Respectfully submitted,

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